

REMARKS

Applicants acknowledge receipt of an Office Action dated November 15, 2007. In this response, Applicants have cancelled claims 2 and 7-10 without prejudice or disclaimer. In addition, Applicants have amended claims 1, 4, and 6. Claim 1 was amended to incorporate the subject matter of claim 2. As such, Applicants have cancelled claim 2 without prejudice or disclaimer. Support for this amendment may be found, *inter alia*, in paragraph [0046] on pages 11 and 12. Following entry of this amendment, claims 1 and 3-6 are pending in the application.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Rejection Under 35 U.S.C. § 112, 2nd Paragraph

On page 2 of the Office Action, the PTO has rejected claims 1-10 under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite. Applicants have amended claims 1 and 2 to remove the term “rubber-like.”

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 112.

Rejection Under 35 U.S.C. § 103

On page 3 of the Office Action, the PTO has rejected claims 1-10 under 35 U.S.C. § 103(a) as allegedly being unpatentable over JP 2002-188057 to Shimozu (hereafter “JP ‘057”), in view of either JP 9-165548 to Fujii (hereafter “JP ‘548”) or JP 2001-207106 to Matsumoto (hereafter “JP ‘106”), and also U.S. Patent 5,527,841 to Inokuchi (hereafter “Inokuchi”). Applicants respectfully traverse this rejection for at least the reasons set forth below.

The framework for the objective analysis for determining obviousness under §103 requires:

1. Determining the scope and content of the prior art;
2. Ascertaining the differences between the claimed invention and the prior art;
3. Resolving the level of ordinary skill in the pertinent art; and

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Teleflex, Inc. v. KSR Int'l Co., 127 S. Ct. 1727, 82 USPQ2d 1385 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). In order to establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Vaack*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See MPEP §2143.03.

Here, JP '057, JP '548, JP '106, and Inokuchi, whether taken individually or in combination, fail to teach or suggest "an elastomer selected from the group consisting of a cross-linked urethane-based polymer, a cross-linked methyl methacrylate-based polymer, a cross-linked acrylic ester-based polymer, and cross-linked butyl methacrylate-based polymer" as presently recited in claim 1.

JP '057 teaches a water-based coating composition containing "(A) polydiorganosiloxane having a Viscosity of 50 to 10,000,000 mPa • s at 25°C and having both terminal ends blocked by hydroxyl groups, (B) a polyorganohydrogensiloxane having at least three hydrogen atoms bonded to its silicon atoms in a molecule, and (C) a curing catalyst." JP '057 Abstract. However, JP '057 does not disclose "an elastomer selected from the group consisting of a cross-linked urethane-based polymer, a cross-linked methyl methacrylate-based polymer, a cross-linked acrylic ester-based polymer, and cross-linked butyl methacrylate-based polymer" as recited in claim 1.

JP '548 fails to resolve this deficiency of JP '057. JP '548 teaches that a coating material may contain "an aqueous dispersion of a chlorinated polyolefin" to enhance adhesion to a substrate. JP '548 Abstract. However, JP '057 fails to teach or suggest "an elastomer selected from the group consisting of a cross-linked urethane-based polymer, a cross-linked methyl methacrylate-based polymer, a cross-linked acrylic ester-based polymer, and cross-linked butyl methacrylate-based polymer" as recited in claim 1.

JP '106 fails to resolve the deficiency of JP '057 and JP '548. JP '106 teaches "an alcohol-condensation curable silicone-based or urethane-based aqueous emulsion coating material with 1-30 pts.wt. (solid basis) of an aqueous emulsion of a chlorinated polyolefin having maleic anhydride group as a reactive group." JP '106. However, JP '106 fails to teach or suggest "an elastomer selected from the group consisting of a cross-linked urethane-

based polymer, a cross-linked methyl methacrylate-based polymer, a cross-linked acrylic ester-based polymer, and cross-linked butyl methacrylate-based polymer” as recited in claim 1.

Inokuchi fails to resolve the deficiency of JP ‘057, JP ‘548, and JP ‘106. Inokuchi discloses a silicone-based coating composition comprising “an aqueous dispersion of a non-flowable organopolysiloxane having a branched molecular structure ... and cured silicone rubber.” Col. 2, lns. 9-42. However, Inokuchi fails to teach or suggest “an elastomer selected from the group consisting of a cross-linked urethane-based polymer, a cross-linked methyl methacrylate-based polymer, a cross-linked acrylic ester-based polymer, and cross-linked butyl methacrylate-based polymer” as recited in claim 1.

Furthermore, the coating agent composition of the presently claimed invention, comprises a coating film having an outstanding adhesiveness, non-tackiness and water repellency that can be formed on the substrate formed of rubber or plastic, and particularly on the substrate formed of foamed or non-foamed EPDM rubber. Since the fine spherical particles (E) are comprised of an elastomer selected from a cross-linked urethane-based polymer, a cross-linked methyl methacrylate-based polymer, a cross-linked acrylic ester-based polymer, and cross-linked butyl methacrylate-based polymer, the coating film has a low coefficient of friction and outstanding lubricity.

For at least these reasons, Applicants submit that the outstanding rejection based upon the combination of JP ‘057, JP ‘548, JP ‘106, and Inokuchi has been overcome and ought to be withdrawn.

If an independent claim is nonobvious under § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicants submit that claims 3-10, each of which ultimately depends from independent claim 1, are also non-obvious at least by virtue of their dependency from claim 1.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 103.

CONCLUSION


Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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